

Application No. 10/706,715
Amendment dated October 14, 2008
Reply to Office Action of July 15, 2008

REMARKS

Applicant amended independent claims 1, 2, 12, 30, and 34, and added new claims 35 and 36 to further define Applicant's invention.

In the Office Action, the Examiner rejected claims 1, 3-9, 12, 13, 15-22, 28, 29, 32, and 33 (including independent claims 1 and 12) under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,322,287 to Chapman et al. ("Chapman"). According to MPEP § 706.02, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." In response, Applicant submits that independent claims 1 and 12, as amended, are patentable over the Examiner's rejection under 35 U.S.C. § 102(b), because Chapman does not teach or suggest each and every limitation thereof.

Independent claims 1 and 12, as amended, are directed to surgical ligation clips each having a maximum clip length between the distal and proximal ends, and a maximum clip height perpendicular to maximum clip length, where "said maximum clip length [is] greater than twice said maximum clip height." Furthermore, amended independent claim 1 recites a connector having "a maximum connector height in a fourth plane perpendicular to the mid-longitudinal axis [of the clip]," where "said maximum connector height [is] equal to said maximum clip height." Amended independent claim 12 recites a connector having a minimum connector width "perpendicular to the mid-longitudinal axis [of the clip]", where "said minimum connector width is equal to said minimum clip width."

Chapman is directed to a veil clasp having jaws (5) and (6) extending from a coil (11) at the proximal end toward the distal end thereof. Furthermore, adjacent the proximal end of the veil clasp, jaw operating members (8) and (9) are provided to facilitate operation thereof. As shown best in Fig. 3, the jaw operating members (8) and (9) extend upwardly from the coil (11). Using the jaw operating members (8) and (9), the jaws (5) and (6) can be manipulated.

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Unlike amended independent claims 1 and 12, however, the maximum height (i.e., the combined height of the jaw operating members (8) and (9)) appears close to being equal to the maximum length (i.e., the length of the jaws (5) and (6) and the coil (11)) of the veil clasp of Chapman. Accordingly, Chapman does not meet the limitations of amended independent claims 1 and 12 requiring that "said maximum clip length [is] greater than twice said maximum clip height."

Furthermore, unlike the surgical ligation clip of amended independent claim 1, the height of the coil (11) does not equal of the maximum height of the veil clasp, and, unlike the surgical ligation clip of amended independent claim 12, the minimum width of the coil (11) is not equal to the minimum width of the veil clasp. Instead, the height of the jaw operating members (8) and (9) equals the maximum height of the veil clasp, and the width of the jaw (6) near the longitudinal center thereof equals the minimum width of the veil clasp. Given that Chapman does not teach or suggest all of the limitations thereof, Applicant submits that independent claims 1 and 12 are patentable over the Examiner's rejection under 35 U.S.C. § 102(b) based on Chapman.

Additionally, the Examiner rejected claims 1-24, 28-30, and 32-34 (including independent claims 1 and 12) under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,858,018 to Shipp et al. ("Shipp '018") in view of U.S. Patent No. 6,226,843 to Crainich ("Crainich"). In promulgating this rejection, the Examiner also appears to rely upon Chapman. (See Office Action at page 5, paragraph 12.) However, whether relying on the combination of Shipp '018 and Crainich with or without Chapman, Applicant submits that amended independent claims 1 and 12 overcome the Examiner's rejection thereof under 35 U.S.C. § 103(a).

In KSR International Co. v. Teleflex Inc. et al., the Supreme Court reaffirmed the framework for governing obviousness under 35 U.S.C. § 103(a) as set forth in Graham et al. v. John Deere Co. of Kansas City et al., 383 U.S. 1, 148 U.S.P.Q. 459 (1966). (See KSR v. Teleflex, 127 S.Ct. 1727 (2007).) Under Graham v. John Deere, the question of

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obviousness is resolved on the basis of factual determinations including (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, (3) the level of ordinary skill in the pertinent art, and (4) where in evidence, so-called secondary considerations. (Graham v. John Deere, at 17-18, 148 U.S.P.Q. at 467.) However, even under Graham v. John Deere, prior art that is non-analogous to the claimed invention, or a combination of references that does not teach or suggest each and every element of the claimed invention supports a finding of nonobviousness. As discussed below, Chapman is non-analogous to the claimed invention, and hence, cannot be used for rejecting independent claims 1 and 12 based on obviousness. Furthermore, the combination of Shipp '018 and Crainich does not teach each and every element of the claimed invention as recited in amended independent claims 1 and 12.

According to MPEP § 2141.01, "a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." Hence, the pertinence of a reference is determined by if the reference can be logically associated with the claimed invention. Given that the jaw operating members (5) and (6) would, by their very nature, interfere with use thereof during surgery, Applicant submits that Chapman would not be reasonably pertinent to the field of surgery, and therefore, from an obviousness standpoint would not be logically associated with the claimed invention. Accordingly, Applicant submits that Chapman cannot be used as the basis for an obviousness rejection of independent claims 1 and 12.

In addition to the recitations discussed above, amended independent claims 1 and 12 recite upper and lower support members each having a maximum width adjacent the distal end perpendicular to the mid-longitudinal axis of the clips, and having a width less than the maximum width thereof over the majority of the length of the clip between the distal and proximal ends thereof. Furthermore, amended

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Independent claims 1 and 12 recite that the clip is formed of a single piece of wire (claim 1) or material (claim 12) having a substantially uniform thickness," where the distal end of the clip has a distal height and the proximal end of the clip has a proximal width, where "each of said distal height and said proximal width twice the thickness of the wire or the material.

Shipp '018 is directed to a surgical ligation clip (16) having a base arm (20) and a pressure arm (22) overlying the base arm (20). The base arm (20) and the pressure arm (22) are spaced apart from one another, and are moveable relative to one another via a pivotal connection at the proximate end (24) of the surgical ligation clip (16). However, unlike amended Independent claims 1 and 12, the base arm (20) and the pressure (arm) surgical ligation clip (16) of Shipp '018 do not each have both a maximum width adjacent the distal end perpendicular to the mid-longitudinal axis of the clips, and have a width less than the maximum width over the majority of the length of the clip between the distal and proximal ends thereof. Furthermore, unlike amended independent claims 1 and 12, the surgical ligation clip (16) of Shipp '018 (at least because the base arm (20) and the pressure arm (22) are spaced apart from one another) does not have a distal end with a distal height and a proximal end with a proximal width, where both the distal height and the proximal width is twice the thickness of the wire or the material forming the clip. As such, Shipp '018 does not teach each and every limitation of amended independent claims 1 and 12.

Crainich is directed to a clip (10) having a head portion (12) joining a first leg (14) and a second leg (16). The first leg (12) and the second leg (14) are pivotable relative to one another. However, unlike amended independent claims 1 and 12, the first leg (14) and the second leg (16) of the clip (10) of Crainich do not each have a maximum width adjacent the distal end perpendicular to the mid-longitudinal axis of the clips, and have a width less than the maximum width over the majority of the length of the clip between the distal and proximal ends thereof. Furthermore, unlike amended independent claims 1 and 12, the clip (10) of Crainich (at least because of the height of

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the head portion (12) does not have a distal end with a distal height and a proximal end with a proximal width, where both the distal height and the proximal width is twice the thickness of the wire or the material forming the clip. As such, Crainich does not teach each and every limitation of amended independent claims 1 and 12. In fact, Crainich does not teach the same limitations of amended independent claims 1 and 12 as Shipp '018.

Given that Shipp '018 and Crainich each do not teach the same limitations of amended independent claims 1 and 12, the combination thereof also fails to teach each and every limitation thereof. Accordingly, Applicant submits that amended independent claims 1 and 12 overcome the Examiner's rejection under 35 U.S.C. § 103(a) based on Shipp '018 and Crainich.

Additionally, the Examiner rejected claims 27 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Shipp '018 and Crainich in view of U.S. Patent No. 6,290,575 to Shipp et al. In response, Applicant submits that the Examiner's rejection of claims 27 and 31 is rendered moot at least because there claims dependent from allowable independent claims 1 and 12.

In conclusion, Applicant submits that amended independent claims 1 and 12 are patentable and that dependent claims 2-11, 13-24, and 27-36 dependent from independent claim 1 or 12, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim. Therefore, in view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Accordingly, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including

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any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

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Dated: October 14, 2008

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